

## Remarks

Claims 49 and 62 have been amended. Accordingly, claims 49- 72 are pending of which claims 51-55, 57, 59- 61, 63-72 have been withdrawn.

Reconsideration and allowance of the pending claims based on the following remarks are respectfully requested.

### REJECTIONS UNDER 35 U.S.C. § 103

I. Claims 49, 50, 58 and 62 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Patent No. 5,825,408 to Yuyama et al. ("Yuyama") in view of U.S. Patent No. 4,190,330 to Berreman ("Berreman").

Applicant disagrees with the propriety of this rejection. However, solely to expedite prosecution, Applicant has amended independent claims 49 and 62 to further clarify aspects of the claimed invention.

Independent claim 49 recites, *inter alia*, the features of:

an optical system with an optical element having a variable focal length characteristic, that uses no polarizing plate, and forms an image whose brightness is independent of a polarized direction of incident light, ***the optical system comprising no lens element that moves along an optical axis;***

\* \* \*

***wherein said optical element having the variable focal length characteristic has a principal point whose location is independent of a polarized direction of the incident light.***

Similarly, independent claim 62 recites, *inter alia*, the features of:

an optical system having a focal point adjusting function which comprises an optical element having a variable focal length characteristic, uses no polarizing plate and forms an image whose brightness is independent of a polarized direction of incident light, ***the optical system comprising no lens element that moves along an optical axis;***

\* \* \*

***wherein said optical element having the variable focal length characteristic has a principal point whose location is independent of a polarized direction of the incident light.***

[Emphasis added].

The cited portions of Yuyuma and Berreman do not render obvious at least the above-emphasized features.

For example, the Office asserts that Yuyuma teaches

... an optical system (column 9, lines 44-64) with an optical element ("lens") having a variable focal length characteristic, that uses no polarizing plate, and forms an image whose brightness is independent of a polarized direction of incident light (The lens is used to focus images to be taken by the camera section, and can be moved in order to zoom in and out, column 10, lines 33-37. Yuyuma et al. teaches that the lens (i.e., the optical element) of the camera is moved along the optical axis in order to enlarge and reduce the image of the subject (i.e., to zoom in and out by varying the focal length). Therefore, the lens has a variable focal length characteristic. As the optical element is a lens, it requires no polarizing plate, and forms an image whose brightness is independent of a polarized direction of incident light.

Office Action, page 3 (emphasis added).

Indeed, the Office further *acknowledges* that "Yuyuma et al. does not explicitly teach that the optical system contains no lens element that moves along the optical axis." Office Action, page 6.

However, the Office Action further asserts that the cited portions of Berreman allegedly overcome these acknowledged deficiencies of Yuyuma. Applicant respectfully disagrees.

Even assuming *arguendo* that Berreman might teach what the Office's asserts (which Applicant does not concede), Applicant submits that modification of Yuyuma in the manner suggested by the Office Action is improper. For example, if the optical system of Yuyuma is modified based on Berreman to achieve the optical apparatus having no lens element that moves along an optical axis recited in Claims 49 and 62, Applicant submits that such modification would be contrary to the teachings of Yuyuma and thus, unsatisfactory for its intended purpose. As the Office *acknowledges*, Yuyuma specifically teaches an optical system which includes a lens that is moved along the optical axis in order to enlarge and reduce the image of the subject for providing a focal point adjusting function. Claims 49 and 62, for example, recite, "the optical system comprising no lens element that moves along an optical axis." Indeed, "... when the prior art teaches away from combining certain known

elements, discovery of a successful means of combining them is more likely to be nonobvious.” *KSR Int’l Co. v. Teleflex Inc.* 82 U.S.P.Q.2d 1385, 1395 (2007) (emphasis added); MPEP § 2143.01 VI (“If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959).”).

Therefore, Applicant respectfully submits that claims 49 and 62 are patentable over the cited portions of Yuyama and Berreman, as the cited portions of Yuyama and Berreman, do not render obvious each and every element recited by claims 49 and 62. Claims 50 and 58 depend from claim 49 and are, therefore, patentable for at least the same reasons provided above related to claim 49, and for the additional features recited therein.

Thus, for at least the foregoing reasons, Applicant respectfully requests that the rejection of claims 49, 50, 58 and 62 under 35 U.S.C. §103(a) over Yuyama in view of Berreman be withdrawn and the claims be allowed.

II. Claim 56 was rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Yuyama in view of Berreman, as applied to claim 49, and further in view of U.S. Patent No. 5,745,289 to Hamblen (“Hamblen”).

As discussed above, the cited portions of Yuyama and Berreman do not render obvious each and every element recited by claim 49.

Further, even assuming *arguendo* that it was proper to combine the teachings of Yuyama, Berreman and Hamblen (which Applicant does not concede), Applicant submits that the cited portions of Hamblen do not overcome the deficiencies of Yuyama and Berreman.

For example, the Office Action merely relies upon Hamblen to allegedly teach a lens comprising a diffractive optical element.

Therefore, Applicant respectfully submits that claim 49 is patentable over the cited portions of Yuyama and Berreman as the cited portions of Yuyama, Berreman, and Hamblen, do not otherwise render obvious each and every element recited by claim 49. Claim 56 depends from claim 49 and is, therefore, patentable for at least the same reasons provided above related to claim 49, and for the additional features recited therein.

Thus, for at least the foregoing reasons, Applicant respectfully requests that the rejection of claims 56 under 35 U.S.C. § 103(a) over Yuyama in view of Berreman and further in view of Hamblen be withdrawn and the claim be allowed.

### Conclusion

Having addressed each of the foregoing rejections, it is respectfully submitted that a full and complete response has been made to the outstanding Office Action and, as such, the application is in condition for allowance. Notice to that effect is respectfully requested.

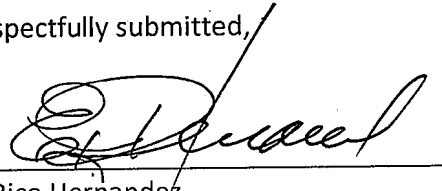
If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

Please charge any fees associated with the submission of this paper to Deposit Account Number 033975. The Commissioner for Patents is also authorized to credit any over payments to the above-referenced Deposit Account.

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